

***IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES***

Applicant: Albert Andrew Murrer III
Title: TRANSPORT CONTAINER
FOR HAZARDOUS MATERIAL
Appl. No.: 10/629,322
Filing Date: 7/28/2003
Examiner: Grosso, Harry A.
Art Unit: 3781
Appeal Number: 2008-1407

REQUEST FOR REHEARING UNDER 37 C.F.R. § 41.52

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Sir:

Applicant (hereinafter "Appellant") submits this Request for Rehearing in response to the Decision on Appeal entered by the Board of Patent Appeals and Interferences on September 30, 2008. No fee is believed to be due in connection with this submission. However, if a fee is deemed due, the Commissioner is authorized to charge such fee to Deposit Account No. 19-0741.

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STATUS OF CLAIMS

Claims 1-10 and 12-25 are pending in the application.

Claim 11 has been cancelled.

Claims 1-5 and 20-24 are withdrawn.

Claims 6-10, 12-19 and 25 are the subject of this appeal.

The pending claims are presented in Appendix A of Appellant's Appeal Brief of January 4, 2007.

ARGUMENT

As addressed herein, the Examiner and the Board have failed to demonstrate that the prior art contains each and every claim element (a partially collapsible container having a soft-sided outer shell) and have failed to identify a motivation to combine the two primary references (Redzisz and Zeddies). In addition, the Board has improperly, *sua sponte*, formulated a new rejection for claims 17-19 to replace the rejection of record, therefore denying Appellant a meaningful opportunity to establish a record and rebut the new rejection.

I. The Board Fails To Demonstrate That The Prior Art Provides Every Element Of The Claims

Claim 6 is the sole pending independent claim. Claim 6 (and all dependent claims) encompass a container system that comprises a “soft-sided outer shell” that is “at least partially collapsible when unsupported.” The Board has failed to demonstrate that the cited prior art of Redzisz et al. (U.S. Patent Publication 2003/0136702; hereinafter “Redzisz”) and Zeddies (U.S. Patent 6,336,342) contains either of these limitations.

In sustaining the Examiner’s rejections, the Board states:

Redzisz teaches ‘a collapsible insulated cooler case [which] includes a sandwich construction of fabric and cell foam material forming the panel walls of the container’ (FF 1). There is no evidence on this record to suggest that the fabric and cell foam construction of Redzisz’ container does not result in a soft sided outer shell as defined by Appellant.”

Decision on Appeal at page 12, lines 4-6 (emphasis added).

The Board reiterates:

There is also no evidence on this record that that the Redzisz’s container does not result in a soft sided outer shell as defined by Appellant.

Decision on Appeal at page 13, second paragraph (emphasis added).

The very language of the Board's Decision evidences the Board's legal error. Rather than arguing the issue in the negative as the Board has done (i.e., that the art is not inconsistent with soft-sided), the Board is obligated to demonstrate that each and every element of Appellant claimed invention is present—in the affirmative (i.e., that the prior art actually teaches a soft-sided, partially collapsible container). In particular, the evidence of record that the Board seeks to determine the structural properties of the Redzisz container is the Redzisz reference itself. Appellant respectfully submits that the Board has clearly applied the wrong standard by focusing on what the art does not teach and bootstraps that analysis in the negative into an inappropriate hindsight reconstruction of the claimed invention. Instead, the Board should look to the actual teachings of the cited prior art references to determine the structural nature of the disclosed elements.

For the reasons discussed below, Appellant submits that the cited prior art fails to teach a container system that is either partially collapsible or has a soft-sided outer shell, as those features are defined in the Specification.

II. The Board Incorrectly Construes “Soft-sided” and “Partially Collapsible”

All pending claims encompass a container system that comprises a “soft-sided outer shell” that is “at least partially collapsible when unsupported.” As noted by the Board, Appellant defines “soft-sided” as having to a “non-rigid characteristic” and including “a surface that can be, for example, bent or folded either easily or with relatively little force.” Specification at [0009], Decision on Appeal at paragraph spanning pages 11-12. “Collapsible” is broadly defined in the Specification as optionally including, for example “an organized reduction in volume through folding” (a reference to a pre-determined volume reduction pattern) and “an unorganized reduction” in volume (a reference to an unstructured volume reduction typical of soft, malleable materials). Specification at [0011]. Thus, the requirement in all pending claims that the outer shell be “soft-sided” mandates that “collapsible” include “an unorganized reduction” in volume. “Collapsibility” in an unorganized way, of a material having a non-rigid characteristic, is an

inherent property. Neither Redzisz nor Zeddies provides a container system that has either a “soft-sided outer shell” or one that is “collapsible” through an unorganized reduction in volume.

Redzisz et al.

The Redzisz Container is Not Soft-sided.

In maintaining all rejections, the Board incorrectly concludes that the Redzisz container has a “soft-sided outer shell.” Decision on Appeal at pages 11-12. In arriving at this conclusion, the Board inappropriately focuses only on the materials from which the Redzisz container is made and argues in the negative that those materials are not inconsistent with a soft sided container. Decision on Appeal at page 12, lines 4-6 and page 13, second paragraph. However, Redzisz discloses the construction materials only in the most general terms and, based on this description alone, it is impossible to determine the structural features of the container.

The generic description in Redzisz that the container is made of foam cell material encased in fabric gives no indication of whether the container has rigid walls or is soft-sided. In order to make this determination, one must look beyond the generic description of construction materials and into the specific teachings of Redzisz.

In each Redzisz example, the container is shown free-standing with no indication that it is collapsible in an unorganized way. For example each of the Redzisz figures depicts a parallelepiped container formed by sharp and well-defined wall panels. Redzisz at Figures 1-9 and [0004]. Nothing in these figures indicates soft-sidedness. Consistent with the notion of having rigid or semi-rigid side walls, each of the Redzisz embodiments are depicted with sharp score lines or stitches to define a folding line. See, for example, Redzisz at Figures 4-11 Decision on Appeal, FF 1, Reply Brief at page 7, Record of Oral Hearing at page 11, lines 5-13 and 21-24. A “soft-sided” container negates the need for the sharp predefined folding lines described by Redzisz. In sum, there is no example or indication in Redzisz of a container in

which the sides themselves are capable of being “bent or folded, either easily or with relatively little force” in a disorganized manner.

Furthermore, Redzisz’ description of the container’s function is inconsistent with a soft-sided outer shell. The Redzisz container is designed to “maintain[] its structural integrity and shape when the case is fully opened.” Redzisz at [0010]. The ability to maintain structural integrity in the fully opened configuration is inconsistent with a soft-sided container; the latter being expected to sag or otherwise at least partially collapse in an unstructured manner because of its non-rigid characteristic. Thus, the evidence supports that the sides of the Redzisz container must be rigid or semi-rigid, not soft-sided.

The Redzisz Container is Not Collapsible.

Relatedly, the Redzisz container is not at least partially collapsible, as defined by Appellant. As discussed above, the requirement in all pending claims that the container comprise a soft-sided outer shell mandates that the container be at least partially collapsible by an unorganized reduction in volume; a feature inherent is a material having a “non-rigid characteristic.” Specification at [0009] and [0011].

The Board incorrectly adopts the specific language of the Redzisz abstract and characterizes Redzisz as providing “[a] collapsible insulated cooler case...” Decision on Appeal, FF 1. Appellant respectfully submits that the use of the term “collapsible” by Redzisz (and adopted by the Board) is not equivalent to “collapsible,” as defined by Appellant. Instead, the Redzisz container is more properly described as a “foldable” container.

In every example, including Figure 11 relied upon by the Board, Redzisz describes a container that folds along pre-determined folding lines. Decision on Appeal, FF 1, see also, Reply Brief at page 7; Record of Oral Hearing at page 11, lines 5-13 and 21-24. For example, Redzisz Figure 11 illustrates a cross sectional view of the container system through the longitudinal side walls and the bottom wall in which the container is folded into a partially closed

position along a predetermined central seam in the “mid seam score line or stitch 80.” See, Redzisz at [0034]. Likewise, each junction between the bottom wall and the longitudinal side walls (elements 52 and 70) is designed to provide pre-determined folding seams that permit the container to be folded into its closed position.

The “opposite end walls” 26 and 28 (i.e., side walls perpendicular to the longitudinal walls) are also designed to fold in a predetermined manner. For example, in Redzisz Figures 3-8, the opposite end walls 28 are illustrated as having a folding seam at the junction with the bottom wall (as described for the junction between the longitudinal wall and the bottom wall), and a central folding seam (unlabeled) that is substantially continuous with the bottom wall mid seam score line 80.

The folding action (i.e., organized reduction in volume) of the Redzisz container is repeatedly illustrated in Figure 3-8. In each figure, the container folds in an organized and structured manner along predetermined seam lines. Nothing in the text of the Redzisz specification is contrary to, or modifies this basic folding structure. In particular, nothing in Redzisz suggests an unorganized reduction in volume (i.e., a reduction in volume other than by folding).

Thus, the Redzisz container is not “at least partially collapsible,” as defined by Appellant, because the Redzisz container cannot collapse in an “unorganized reduction” in volume. In each case, the Redzisz container is illustrated and described as being foldable along predetermined folding seams. Folding is an “organized reduction” in volume only, which does not satisfy Appellant’s requirement for “partially collapsible,” as that term is used in the context of a soft-sided outer shell.

Zeddies

In characterizing Zeddies, the Board makes the same two fundamental errors as it did in characterizing Redzisz. Specifically, the Board characterizes Zeddies as not requiring substantially rigid walls, and inappropriately conflates “foldability” and “collapsibility.”

With respect to the outer shell, Zeddies provides no more than Redzisz. The Zeddies container consists of substantially rigid walls joined by bend lines which allow “opposite sides of the bend line... to be folded into an adjacent condition.” Decision on Appeal, FF 6, citing Zeddies at col. 4, ll. 16-20. A simple inspection of the Zeddies figures and accompanying description reveals that the only volume reduction mechanism contemplated is a folding mechanism, consistent with substantially rigid outer walls. Although the Board characterizes Zeddies Figure 3 as showing “an optional wall structure” and emphasizes that Zeddies “may” comprise a substantially rigid panel, neither the Board nor the Examiner has provided any evidence that Zeddies contemplates a soft-sided outer shell. Decision on Appeal, FF 5 and page 13, lines 3-4. Thus, while the substantially rigid panel 31 may be optional, Zeddies provides no indication that the walls as a whole should not maintain a substantially rigid character.

Summary

In sum, the combination of Redzisz and Zeddies (the primary combination of references on which all rejections are based) fails to teach a container having an outer shell that is “soft-sided” and “at least partially collapsible,” as those terms are used in the claims and are defined by Appellant. In finding that Redzisz and Zeddies each disclose containers having soft-sided outer shells, the Board inappropriately argues in the negative, focusing solely on the generic description of construction materials. By ignoring the substantive teachings of the cited prior art, the Board incorrectly concludes that Appellant’s claimed invention is obvious because, based on common materials, its construction is not inconsistent with the prior art containers.

motivation to add an internal frame, such as the one described by Zeddies. Appellant respectfully traverses.

Appellant submits that, generally, an internal frame is placed inside a container when the container lacks the requisite structural rigidity or strength for the desired purpose. For example, Appellant teaches that the instant inner frame is inserted into the outer shell, wherein the inner frame is adapted to support the outer shell in an assembled configuration and protect the hazardous material inside. Specification at [0024] and [0043]. Thus, there is no motivation to use an internal frame with containers that have sufficient structural strength and rigidity for the desired purpose.

Nothing in Redzisz suggests that the disclosed container is lacking in structural strength or is deficient in any way for its intended use. The Redzisz container is described as being designed and intended to maintain its structural integrity when the case is fully opened. Redzisz at [010]. Furthermore, Redzisz includes rigid or semi-rigid plate members 76 and 78 in the bottom wall of the container. Redzisz at Figure 11 and [0034]. There is nothing in Redzisz to suggest that the disclosed container lacks sufficient structural strength for its desired purpose or otherwise requires an inner frame for support. In contrast, the use of an internal frame in Zeddies is motivated by its loosely-secured sidewall design, maintained with Velcro straps. Thus, the requisite motivation is negated because the Redzisz container is capable of maintaining its structure.

In sum, the Board and the Examiner have failed to identify a valid motivation to combine the teachings of Redzisz and Zeddies and Appellant respectfully submits that no motivation exists. The fact that the Redzisz container is free-standing and maintains its structural integrity negates any motivation to provide an additional structural element such as a removable internal frame. In maintaining these rejections, the Board and the Examiner have merely identified the various elements of Appellant's claimed invention in the prior art. This is insufficient to sustain a *prima facie* case of obviousness and represents a second independent basis for reversing and withdrawing all rejections.

Appellant respectfully submits that the Board's analysis is inconsistent with the law of obviousness because the Board has not affirmatively identified in the prior art every element of recited in the rejected claims. In particular, the Board has failed to affirmatively demonstrate that the combination of Redzisz and Zeddies provides a container system having a soft-sided outer shell which is partially collapsible.

Appellant further submits that the cited prior art, even when analyzed correctly, fails to support a *prima facie* case of obviousness. The Redzisz containers are intended to maintain their structural integrity in the open configuration. This would not be possible for a soft-sided container having walls with a "non-rigid characteristic." Specification at [0009]. Likewise, the Board and the Examiner has pointed to nothing in Zeddies that is consistent with the use of non-rigid materials. Additionally, neither Redzisz nor Zeddies provides a container that is "partially collapsible" by an unstructured reduction in volume; a feature mandated in the claims by virtue of the requirement for a soft-sided outer shell having a non-rigid characteristic. Specification at [0011].

This basis for traversal applies to all appealed claims. Therefore, all rejections should be reversed and withdrawn.

III. There Is No Motivation To Combine the Zeddies Frame With The Redzisz Container

All pending claims stand rejected over the combination of Redzisz and Zeddies. Appellant respectfully submits that there is no motivation to combine the teachings of these references and, as such, provides a second independent basis for reversal of all rejections.

Appellant has argued repeatedly that there is no motivation to combine Redzisz and Zeddies. Reply Brief at pp. 6-8; Record of Oral Hearing, page 6. In its Decision, the Board implies that the Redzisz container is a soft-sided container which "may include a surface that can be, for example, bent or folded, either easily or with relatively little force." Decision on Appeal, paragraph bridging pages 12-13. The Board implicitly concludes that this provides the requisite

IV. Claims 17-19: The Board Has Incorrectly Characterized Travis
As Providing an Internal Frame.

Claims 17-19 stand rejected as obvious over the combination of Redzisz, Zeddies, and Travis (U.S. Patent 4,585,159). In maintaining this rejection, the Board has made the same fundamental flaw in its characterization of Travis that was made by the Examiner. In its Decision, the Board states:

Travis teaches an internal frame having side walls that are linked to the ends of longitudinal walls (Ans. 7; FF17).

Decision on Appeal at page 22, paragraph 2.

This is incorrect. The title of the Travis patent is “Collapsible Container and Frame.” Travis provides a container having longitudinal walls, side walls and a bottom wall, and an internal wire frame which is devoid of longitudinal walls, side walls, and a bottom. See, for example, Travis at Figures 1-4. In particular, Travis’ Figure 3 depicts an example of the unfolded container walls and Figure 4 depicts the inner wire frame. See also, Travis at Figures 12-14.

The Examiner misapplies the combination of Redzisz and Travis. If one were to combine the frame of Travis with the container of Redzisz, as alleged by the Examiner, one would take the internal wire frame of Travis (not the entire Travis container) and place it inside the Redzisz container in the open configuration. However, the Travis internal wire frame fails to satisfy the requirements of Appellant’s inner frame because the Travis frame lacks a pair of opposing, rigid longitudinal walls and a pair of opposing collapsible side walls, as specified in claim 17.

To make this rejection, the Examiner was compelled to allege that one is motivated to place the entire Travis container within the Redzisz container, in order to provide a structure with an internal frame function. This combination, however, is not supported by any evidence of record. Specifically, the Examiner has provided no evidence (other than unsupported personal opinion) that the artisan is motivated to place one entire container (Travis’ container) inside the

Redzisz container. Instead, Appellant submits that the artisan is motivated to select for use either the Redzisz container or the Travis container, but is not motivated to place one inside the other. Reply Brief at page 9.

In sum, the Examiner has failed to identify in the prior art an inner frame for use within a container system that conforms to the inner frame requirements of Appellant's claim 17. Instead, the Examiner points to a completely different container system and alleges that it is obvious to use that system as an inner frame, but fails to provide a motivation to do so. Appellant respectfully requests reconsideration and reversal of the rejection of claims 17-19.

V. The Board Has Effectively Applied A New Rejection Against Claims 17-19

Appellant respectfully submits that, for the foregoing reasons, all pending claims are unobvious over the cited prior art and that all rejections should be reversed and withdrawn. However, at a minimum, the Board should reverse the rejection of record for claims 17-19 and remand to the Examiner for further consideration. Remand is appropriate because the Board has not affirmed the Examiner's rejection, but has instead replaced it with a new rejection against which Appellant has not had the opportunity to argue or build a record.

Appellant appealed the Examiner's rejection of claims 17-19 over the combination of Redzisz, Zeddies, and Travis. The Examiner's alleges that claims 17-19 are unpatentable because "Redzisz and Zeddies disclose the container of claim 6" and

[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of the frame structure as disclosed by Travis in the container disclosed by claim 6 to provide an inner frame that would be less bulky and fold flat with a thinner profile for handling and storage.

Examiner's Answer at page 7, paragraph 11 (emphasis added).

As discussed above, the argument on appeal essentially rebuts the Examiner's rejection based on the use of either Travis' internal wire frame or entire container system as an inner frame

in the Redzisz container. Specifically, Appellant argued that Travis' internal wire frame lacks the required elements of claim 17, and the artisan is not motivated to place the entire Travis container system (walls and internal wire frame) inside the Redzisz container. See, for example, Reply Brief at page 9.

However, the Board bases its affirmation of the rejection of claims 17-19 on an entirely different theory which requires a modification of the Zeddies inner frame based on the disclosure of Travis, rather than on the Examiner's argument for inserting the entire Travis frame (or container) into the Redzisz container. Specifically, the Board appears to be relying on the basic combination of the Zeddies inner frame with the Redzisz container, but wherein the Zeddies frame has been modified with the hinging mechanism of Travis' frame. The Board states:

There is no evidence on this record to suggest that the pivotable mounts of Zeddies' frame could not be replaced with the wall linkages taught by Travis to accomplish the same purpose of allowing the frame to collapse in a manner that reduces the distance between the frame's longitudinal walls.

Decision on Appeal at page 22, paragraph 2 (emphasis added).

Appellant agrees that there is no evidence on the record regarding the substitution of the Travis wall linkages for the Zeddies pivotable mounts because this was not the rejection asserted by the Examiner. Thus, Appellant never had the opportunity to address this new theory during prosecution which could include, for example, evidence relating to motivation to combine, expectation of success, and level of skill in the art.

Appellant additionally points out that, even in asserting this new basis for rejection, the Board has again incorrectly applied the law of obviousness. The Board again incorrectly argues that there is no evidence to suggest that the pivotable mounts of the Zeddies' frame could not be replaced. The Board has failed to correctly demonstrate how one would replace the Zeddies mounts and that one would be motivated to replace the Zeddies mounts with a reasonable expectation of success.

Appellant respectfully submits that prosecution should be reopened in order to build an appropriate record on this issue. It would be manifestly unfair for the Office to *sua sponte* apply and affirm a new basis for rejection over which Appellant has had no meaningful opportunity to rebut.

CONCLUSION

For the reasons discussed above, Appellant respectfully submits that claims 6-10, 12-19 and 25 are in condition for allowance, and respectfully request that the Board reconsider and reverse all rejections. Appellant further submits that, at the very least, prosecution should be reopened in order that a record can be developed with respect to the Board's new-found basis for combining Zeddies and Travis in the rejection of claims 17-19.

Respectfully submitted,

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